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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,542	01/30/2001	Ehud Levy	40654/252166	9253

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EXAMINER

OCAMPO, MARIANNE S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/772,542

Applicant(s) *TC-4*

LEVY, EHUD

Examiner

Marianne S. Ocampo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-41 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 24, 26, 28, 31 - 39 and 41, drawn to a filtration media (or element) used in a filter for treatment of drinking water, classified in class 210, subclass 503.
- II. Claims 29 and 40, drawn to a filter apparatus for filtration of drinking water, classified in class 210, subclass 490.
- III. Claims 25 and 30, drawn to a method of using zirconia as a filtration media, classified in class 210, subclass 767.
- IV. Claim 27, drawn to a method of regenerating a filtration media composed of zirconia, classified in class 210, subclass 791.

2. The inventions are distinct, each from the other because of the following reasons:

a). Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

claimed because one of the filtration media (i.e the second filtration media) which is composed of zirconia does not require the exact composition or materials of zirconia, as well as the other materials making up the filtration media in the subcombination such as the aluminosilicate, alumina, activated carbon and binder material to form the filtration media. The subcombination has separate utility such as an absorbent material in other types of filter apparatus other than for treatment of drinking water, such as gas and oil filters.

b). Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, other types of filtration media, other than those with or composed of zirconia, can be use in the instant process of removing fluorides and/or arsenic from drinking water. In addition, the media composed of zirconia may also be used in other applications including in gas or oil filtration apparatus as an adsorbent material.

c). Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the filtration media composed of zirconia (i.e. the product) may be used in a materially different process such as an adsorbent in other types of filtration applications such as in gas or oil filtration processes.

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d). Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process can be practiced by another materially different apparatus, in other words, other types of filtration media and apparatus can be used to remove fluorides or arsenic from drinking water.

e). Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects and functions, for instance, the method in the instant claim 27 which is group IV invention, is for regeneration of a filtration media composed of zirconia only, while the apparatus in the group II invention is for filtration of drinking water using two different types of media in series.

f). Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different effects. The invention in group III invention is using a filtration media composed of zirconia for removal of fluorides or arsenic from water, while the invention in group IV invention is regeneration of the filtration media composed of zirconia after it has been used in removal of certain ions (which could be fluorides or arsenic or others).

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Specie I, involving a filtration media composed of only zirconia, activated carbon and a binder material;

Specie II, involving a filtration media composed of zirconia, aluminosilicates, activated carbon and a binder material;

Specie III, involving a filtration media composed of silica gel, activated carbon and a binder material;

Specie IV, involving a filtration media composed of zirconia, silica gel, activated carbon and a binder material;

Specie V, involving a filtration media composed of zirconia and a binder material;

Specie VI, involving a filtration media composed of zirconia, silica gel and a binder material;

Specie VII, involving a filtration media composed of zirconia, silica gel, aluminosilicate activated carbon and a binder material;

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Specie VIII, involving a filtration media composed of silica gel, aluminosilicate and activated carbon;

Specie IX, involving a filtration media composed of silica gel and carbon block;

Specie X, involving a filtration media composed of zirconia, silica gel, aluminosilicates and activated carbon (no binder material);

Specie XI, involving a filtration media composed of silica gel and activated carbon only;

Specie XII, involving a filtration media composed of silica gel, zirconia and carbon block;

Specie XII, involving a filtration media composed of zirconia only, and

Specie XIV, involving a filtration media composed of zirconia and activated carbon only.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of claims are generic.

Claims 1 – 6 and 10 – 12 correspond to specie I;

Claims 7 – 9 correspond to specie II;

Claims 13 – 14 correspond to specie III;

Claims 15 – 17 correspond to specie IV;

Claims 18 – 21 correspond to specie VI;

Claims 22 – 24 correspond to specie VII;

Claim 26 corresponds to specie V;

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Claims 31 and 35 correspond to specie VIII;

Claim 32 corresponds to specie IX;

Claims 33 and 36 correspond to specie X;

Claims 34 and 38 correspond to specie XI;

Claim 37 corresponds to specie XII;

Claims 28 and 39 correspond to specie XIII; and

Claim 41 corresponds to specie XIV.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to



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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*MSO*  
M.S.O.  
September 21, 2002

*M. Savage*  
**MATTHEW O. SAVAGE**  
**PRIMARY EXAMINER**